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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
THOMASSON, MEAGAN J	
ART UNIT	PAPER NUMBER
3714	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

Office Action Summary	Application No.	Applicant(s)	
	10/657,409	BAERLOCHER ET AL.	
	Examiner	Art Unit	
	Meagan Thomasson	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 June 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) *21-96* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *21-96* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *9/8/03* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *See Continuation Sheet*.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. *8/28/07*.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :1/16/07,12/12/06,3/21/05,2/10/05,1/11/05.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of claims 1-20 in the reply filed on June 21, 2007 is acknowledged. The traversal is on the ground(s) that the species of claim Groups I-IV and Groups V-VII have similarities in the claims that would require a common field of search and thus there is no undue burden on the examiner. This is found to be partially persuasive.

The requirement for restriction, mailed June 13, 2007, restricted the claims in groups as:

I. Claims 1-20, drawn to a method of operating a gaming device wherein game chips are placed according to a table in memory.

II. Claims 21-40, drawn to a method of operating a gaming device wherein multiple tables are used to determine game chip placement.

III. Claims 41-47, drawn to a method of gaming wherein no tables are used to determine game chip placement and a player is awarded based on a combination of values associated with positions having remaining player chips.

IV. Claims 48-52, drawn to a method of gaming wherein no tables are used to determine game chip placement and a player is awarded based on a combination of values associated with each remaining player chip.

V. Claims 53-69, drawn to a method of gaming wherein chips have multiple sides and points are associated individually with each of the positions, and wherein the points for positions occupied by at least one of the first side and second side chips are accumulated.

VI. Claims 70-85, drawn to a method of gaming wherein chips have multiple sides and points are associated individually with and accumulated for at least one of the first side and second side chips that are placed onto positions of the board.

VII. Claims 86-96, drawn to a method of gaming wherein chips have multiple sides and a plurality of different points are provided with the first side chips prior to placement of the chips, and wherein a player can selectively place first side chips with certain amounts of points onto desired positions

The examiner acknowledges that claim groups I to IV are related in that they are drawn to a method of operating a gaming device, generally including, amongst other elements, similar subject matter such as a playing board having a plurality of positions and enabling a plurality of chips to be placed individually at one of the positions. However, the claim groups would require different searches, i.e. different search queries, and thus place an undue burden on the Examiner.

For instance, claim group I, drawn to a method of operating a gaming device wherein game chips are placed according to ***a table*** in a memory and ***said table is weighted*** according to a desired total number of player chips remaining after a player

places each of a provided amount of player chips onto the positions, would require a different search query from claim groups III and IV, which are drawn to a method of gaming wherein ***no tables*** are used in determining chip placement (emphasis added). That is, a search query for claim groups III and IV would likely render no prior art meeting the weighted table limitations of claim group I. Additionally, the various embodiments are recognized divergent subject matter in the art, as a game featuring the tabular decision making process disclosed in claim group I is distinct from a game having no tabular decision making process, as disclosed in claim groups III and IV (similar reasoning applies for divergent subject matter of claims group II).

Likewise, claim group II is directed to a method of operating a gaming device related to the methods of claim groups I and III, however claim group II contains limitations directed to using ***a table*** in memory to place one of the game chips onto one of the positions wherein the table is structured to be particular to a previous placement of one of the player chips onto one of the positions and using ***other tables*** particular to other positions that were available to the player for the previous placement (emphasis added), such that a search query for claim group II would likely render no prior art meeting the weighted table limitations of claim group I nor the limitations of claim groups III and IV that do not include tables for determining chip placement.

However, the examiner agrees that claim groups III and IV have subject matter similar enough such that a common field of search is appropriate for the examination of such groups. Similarly, the examiner agrees that claim groups V to VII have subject matter similar enough such that a common field of search is appropriate for the

examiner of such groups. Therefore, the new claim groups in the restriction requirement are as follows:

I. Claims 1-20, drawn to a method of operating a gaming device wherein game chips are placed according to a table in memory.

II. Claims 21-40, drawn to a method of operating a gaming device wherein multiple tables are used to determine game chip placement.

III. Claims 41-47 and 48-52, drawn to a method of gaming wherein no tables are used to determine game chip placement

IV. Claims 53-69, 70-85 and 86-96, drawn to a gaming device comprising a plurality of chips having a first side and a second side for representing a first player and a second player, respectively.

The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

During a telephone conversation with Adam Masia on August 28, 2007 a provisional election was made without traverse to prosecute the invention of group I, claims 1-20. Affirmation of this election must be made by applicant in replying to this

Office action. Claims 21-96 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. See attached interview summary.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-4,12-14,19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al. (US 7,018,293 B2) in view of Watanabe (US 5,833,238).

Regarding claim 1, Brown discloses a method of operating a gaming device comprising;

displaying a play board having a plurality of positions (Fig. 8-20, abstract),

enabling each of a plurality of chips to be placed individually at one of the positions, the chips being either game chips or player chips, wherein placement of one of the player chips that causes at least one game chip to be flanked on opposite sides by player chips converts each said flanked game chip to a player chip (col. 12, lines 52-63),

using a table in memory to place at least one chip at one of the positions, wherein the table is weighted according to a desired total number of player chips remaining after a player places each of a provided amount of player chips onto the positions (Table 3, Number of Bonus Round Placement Attempts as a function of number of player pieces remaining, wherein each bonus round placement attempt results in the placement of a chip on the game board),

awarding the player based on the remaining number of player chips after the player placed the provided amount of player chips onto the positions (Table 8, wherein Number of Pieces at end of bonus round determines bonus award pay).

Brown does not specifically disclose placement of one of the game chips that causes at least one player chip to be flanked on opposite sides by game chips converts each said flanked player chip into a game chip utilizing a table in memory to place at least one game chip. That is, after the initial board set-up, no additional game chips are placed on the board. Instead, player chips are added such that they flank game chips and convert said flanked game chips into player chips until a player chips is placed on a board position containing a Collect indicia (col. 13, lines 3-15). In an analogous method of operating a gaming device, Watanabe discloses a similar playing board having a

plurality of positions wherein multiple players alternate placing chips on said playing board in order to occupy positions surrounding an opponent's chips. If a player's chip is flanked on either side by an opponent's (i.e. game's) chips, said player chip is converted into an opponent's (i.e. game's) chip (col. 7, lines 6-17). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the bonus game disclosed in Brown with the game of Watanabe in order to create a bonus game wherein placement of one of the game chips that causes at least one player chip to be flanked on opposite sides by game chips converts each said flanked player chip to a game chip as Watanabe discloses an embodiment of said game wherein embodiment is controlled by electronic means (col. 6, lines 29-37). The inventions are analogous and in the same player entertainment field of endeavor.

Regarding claim 2, Brown discloses placing an initial configuration of game and player chips on the board, leaving a plurality of possible positions to place additional chips to thereby convert one of the initially placed chips (col. 12, lines 36-40).

Regarding claim 3, *Brown does not specifically disclose generating one of the possible positions to be filled by one of the game chips to thereby convert one of the player chips to a game chip.* That is, after the initial board set-up, no additional game chips are placed on the board. Instead, player chips are added such that they flank game chips and convert said flanked game chips into player chips until a player chips is placed on a board position containing a Collect indicia (col. 13, lines 3-15). In an analogous method of operating a gaming device, Watanabe discloses a similar playing board having a plurality of positions wherein multiple players alternate placing chips on

said playing board in order to occupy positions surrounding an opponent's chips. If a player's chip is flanked on either side by an opponent's (i.e. game's) chips, said player chip is converted into an opponent's (i.e. game's) chip (col. 7, lines 6-17). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the bonus game disclosed in Brown with the game of Watanabe in order to create a bonus game wherein placement of one of the game chips that causes at least one player chip to be flanked on opposite sides by game chips converts each said flanked player chip to a game chip as Watanabe discloses an embodiment of said game wherein embodiment is controlled by electronic means (col. 6, lines 29-37). The inventions are analogous and in the same player entertainment field of endeavor.

Regarding claim 4, Brown discloses enabling the player to select one of the possible positions to be filled by one of the player chips to thereby convert one of the game chips to a player chip (col. 16, lines 52-57).

Regarding claim 12, *Brown does not specifically disclose structuring the table to be particular to a previous placement of one of the player chips.* That is, the placement of a gaming chip is not decided based upon the previous placement of one of the player chips as, as stated above, Brown does not disclose placing additional gaming chips on the board after the initial board set-up. However, Watanabe discloses alternating placing player chips and gaming chips (i.e. player's opponent's chips) on the game board wherein an opponent's chip placement is inherently based upon the previous placement made by the player. Therefore, it would have been obvious to one of ordinary skill in the art to structure the table for determining the placement of gaming chips to be

particular to a previous placement of one of the player chips, as Watanabe teaches of a game wherein chip placement decisions made by an opponent are inherently based upon the previous placement decision made by a player.

Regarding claim 13, Brown discloses an embodiment of the bonus game invention which includes structuring the provided amount of player chips to be less than half of a total number of positions on the board. For example, col. 12, lines 7-10 discloses that the bonus game board is a six by six board, having a total of 36 positions (Fig. 8-20). The bonus round may end prior to the player placing 18 chips, as shown in the pay table of Fig. 8-20.

Regarding claim 14, Brown discloses flanked the player chips on opposite sides includes flanking the player chips in diagonal, horizontal or vertical line with game chips (Fig. 8-20 show multiple ways of flanking chips).

Regarding claims 19 and 20, Brown discloses the game may be played via a data network, wherein the data network includes an internet (col. 3, lines 13-29), or a computer storage device.

Claims 5-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (US 7,018,293 B2), Watanabe (US 5,833,238) and further in view of Hughs-Baird et al. (US 6,439,995 B1).

Brown/Watanabe as combined above does not teach awarding the player based on a combination of values randomly associated with positions having the remaining player chips, associating the values individually with each of the positions prior to game

play, and displaying the values to the player during game play such that the values of the positions having the remaining chips when the player chips are first displayed in the positions. Instead, Brown discloses awarding a player based upon the number of player chips remaining at the conclusion of the bonus round (bonus game paytable **116**, Fig. 8-24; col. 11 lines 60-62). However, this method of awarding a player in a bonus game (wherein the award value is based on a combination of values associated with positions) is well known to one of ordinary skill in the art. Hughs-Baird teaches a bonus game wherein a player selects game board positions such that the resulting bonus game award value is a combination of said selected positions (col. 3, lines 30-42). The values associated with the positions are randomly determined prior to the start of bonus game play (col. 5, lines 42-55), are revealed to the player during play of the bonus game (col. 6, lines 47-57), and include selecting the values from the group consisting of game credits, game credit multipliers, a number of free spins, a number of free games, a number of picks from a prize pool, a non-monetary award and any combination thereof (Fig. 3). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Brown, Watanabe and Hughs-Baird in order to provide a bonus game wherein awarding the player is based on a combination of values associated with positions having player chips as the inventions are analogous gaming devices in the same field of endeavor.

Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (US 7,018,293 B2), Watanabe (US 5,833,238) and further in view of Frost et al. (US 2002/0090988 A1).

Brown/Watanabe as combined above does not teach structuring the award to include a combination of values associated with the remaining player chips, displaying the values of the remaining player chips when the player chips are first displayed, providing player chips having display values to the player, nor display values associated with the player chips even after the associated player chips are converted to game chips.

Instead, Brown discloses awarding a player based upon the number of player chips remaining at the conclusion of the bonus round (bonus game paytable **116**, Fig. 8-24; col. 11 lines 60-62). However, this method of awarding a player in a game (wherein the award value is based on the combination of values associated with chips) is well known to one of ordinary skill in the art. Frost discloses a gaming device wherein a player may selectively place chips having an associated value on a board, i.e. a roulette game, as shown in Fig. 3. At the conclusion of the game, the combination of values associated with the chips determines the amount a player receives as an award (§ 0061, wherein multiple chips may be assigned to a single positions such that the total award value is a combination of said multiple chip values). It would have been obvious to combine the teachings of Brown, Watanabe, and Frost in order to provide a game wherein awarding the layer is based on a combination of values associated with chips as the inventions are analogous gaming devices in the same field of endeavor.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pertinent prior art includes:

- Cannon (US 2003/0125100 A1; 7,077,744), drawn to an Othello type gaming device comprising player chips and game chips.
- Watanabe et al. (US 2002/0160836), drawn to an Othello type gaming device comprising hand held gaming devices.
- Lawless (US 7,168,704), drawn to a game featuring player chips and game chips.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meagan Thomasson whose telephone number is (571) 272-2080. The examiner can normally be reached on M-F 830-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Robert E Pezzuto
Supervisory Patent Examiner
Art Unit 3714

Meagan Thomasson
August 28, 2007